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OFFICE OF PETITIONS

In re Application of :
Weiglhofer et al. :
Application No. 09/199,188 :
Filed: November 24, 1998 : ON PETITION
Title of Invention: :
3D STEREO REAL-TIME SENSOR :
SYSTEM, METHOD AND COMPUTER :
PROGRAM THEREFOR :

This is a decision on the petition under 37 CFR 1.137(a), filed August 10, 2004, to revive the above-identified application based upon unavoidable abandonment of the application, and on the alternative petition under 37 CFR 1.137(b), based upon unintentional abandonment.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

Applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.37"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor, AND BE ADDRESSED TO petitions Attorney Derek L. Woods. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Background

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Notice of Allowability, mailed February 14, 2001. The Notices set a non-extendable statutory period for reply of three (3) months. No reply having been received, the above-identified application

became abandoned May 15, 2001. A Notice of Abandonment was mailed on April 29, 2004.

Applicable Law

Petition under 37 CFR 1.137(a) for unavoidable abandonment

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks items (1) and (3).

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.¹ 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee ... at any time ... if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added).

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of

¹ The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12

U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")).

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1787 (Fed. Cir. 1995) (citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat.

1990; Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)). However, "The question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."² Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.³ The statute requires a "showing"

² Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

³ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted

by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Applicant is further advised that the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Finally, a "delay (in responding) resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or MPEP, [] does not constitute unavoidable delay." MPEP 711.03(c).

The instant petition

Applicant files the instant petition and avers that the Office improperly abandoned the application. The Office mailed a Notice of Allowance and Notice of Allowability on October 2, 2000. In response to the Notices, Applicant filed a CPA on December 18, 2000, in order to bring to the attention of the Examiner an Information Disclosure Statement ("IDS"). Applicant

the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

alleges that the application should not have been abandoned because of the CPA filing.

Analysis of the instant petition

As to item (1), Applicant has failed to submit the required reply. Here, the required reply consists of the issue fee and corrected drawings. The Office received formal drawings after the application was abandoned, on March 16, 2001; however, a review of the application file and of the instant petition reveal that there is no authorization to charge the issue fee to deposit account 04-1699. A review of the application transmittal documents filed with the application on November 24, 1998, reveal an authorization to charge deposit account 08-1641 the issue fee; however, it is noted that Applicant has changed correspondence addresses and provided a new and different deposit account number. The new deposit account number has apparently replaced deposit account number 08-1641, as Applicant states in the correspondence address change that "[o]ur deposit account is No. 04-1699.". No authorization to charge the issue fee to deposit account no. 04-1699 has been provided.

As to item (3) Applicant has not provided an adequate showing of unavoidable delay. Applicant apparently misunderstood the Notice of Abandonment mailed June 18, 2001, as referencing the October 2, 2000 Notice of Allowance and Notice of Allowability⁴. A review of Office records reveal that, in response to the CPA, Applicant received Notices of Allowance and of Allowability, mailed February 14, 2001. Applicant is advised that it is the failure to timely and properly respond to these February 14, 2001, Notices that resulted in the Abandonment of the application, and not the failure to respond to the Notices mailed October 2, 2000. A review of the application file and the Notice of Allowability reveal, while an authorization to charge Applicant's deposit account, no. 08-1641, was in the application file, applicant failed to timely submit formal drawings in response to the Notice of Allowability.

Finally, applicant requests an extension of the patent term; however, the application was properly held abandoned by this

⁴ Applicant states in the petition that, "[i]n lieu of paying the issue fee for this application due Jan. 2, 2001, Applicants filed a CPA Application on December 18, 2000 in order to bring to the attention of the Examiner references cited in the EP Search Report in connection with the parent priority application." The Notice of Allowance mailed October 2, 2000 required payment of the issue fee not later than Jan. 2, 2001, in order to avoid abandonment.

Office. It was applicant's misunderstanding of the Notice of Abandonment, and subsequent failure to investigate the Notice of Abandonment, which led substantially to the period of abandonment herein.

Applicant is reminded that a delay (in responding) resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or MPEP, [] does not constitute unavoidable delay." MPEP 711.03(c).

Conclusion

Accordingly, the application remains abandoned and the requirement for the issue fee remains outstanding.

Petition under 37 CFR 1.137(b) for unintentional abandonment

A grantable petition under 37 CFR 1.137(b)⁵ must be accompanied by: (1) the required reply,⁶ unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). (Emphasis supplied).

Applicant lack item (1). For reasons noted *supra*, Applicant has failed to file the required reply: the issue fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

⁵ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

⁶ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

By hand: 2201 South Clark Place
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Telephone inquiries concerning this matter should be directed to
Petitions Attorney Derek L. Woods at (571) 272-3232.



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